

REMARKS

Claims 7-47 are pending in the application.

35 U.S.C. § 103:

- Claims 17-47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nilsson (U.S. Patent No. 3,643,521 [hereinafter “Nilsson”]) in view Chiba (JP 04046216 A [hereinafter “Chiba”]).
- Claims 17-47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nilsson in view Yabe, et al. (U.S. Patent No. 5,678,927 [hereinafter “Yabe”]).
- Claims 17-47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nilsson in view of Asai, et al. (U.S. Patent No. 5,501,526 [hereinafter “Asai”]).

Nilsson is applied in each of the three rejections in substantially the same manner. It is acknowledged by the Examiner that Nilsson does not disclose: 1) a lubricant supply device that contains a lubricant oil or grease; or 2) a side that extends radially inward to cover an axial end portion of the lubricant supply device (see Office Action dated page 3, lines 9 and 10; page 5, lines 4 and 5; and page 6, lines 21 and 22).

A) THERE IS NO MOTIVATION TO MODIFY NILSSON WITH EITHER OF CHIBA, YABE OR ASAI TO INCLUDE A LUBRICANT SUPPLY DEVICE OR MEANS FOR STORING A LUBRICANT

Independent claims 17, 18, 19, 22, 31, 32, 33 and 34 recite a lubricant supply device. A skilled artisan will appreciate that a lubricant supply device is a device which supplies lubricant. Claim 36 recites a means for supplying a lubricant. Dependent claims 37-45 recite that the lubricant supply device or means for supplying the lubricant contains a lubricant oil or grease.

It has long been held that the Examiner must “show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for a combination in the manner claimed.” *In re Rouffet*, 47 USPQ2d 1453 (Fed.Cir. 1998). Also, the mere fact that references can be “combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination [or modification].” *In re Mills*, 916 F.2d 680 (Fed.Cir. 1990); MPEP §2143.01.

The sealing member 17 of Nilsson does not “supply” any lubricant or “contain” a lubricant oil or grease. The sealing member 17 is used to maintain grease within the chamber 23, as explicitly noted in column 2, lines 14-17 of Nilsson. Basically, the sealing member 17 acts as a “safety valve” to allow grease to pass when a surplus of grease is present in the chamber 23. (*See Id.*)

Nilsson explicitly requires that its lubricant (for the shaft) comes from the grease stored in the area 23 and not the sealing member 17, which is disclosed as being made of p.t.f.e. or a similar synthetic resin having good frictional properties and a certain resiliency. (See column 1, lines 44-47 of Nilsson.) As shown in Figure 2 of Nilsson, the screw member (not labeled) extends through the seal member 17 to connect the seal member 17 to the nut 11 and, thus, would naturally need to be resilient. There is no teaching in the prior art to gratuitously modify the resilient sealing member 17 of Nilsson to be a lubricant supply device, when a “surplus” of grease is already stored in the area 23. Modifying the sealing member 17 to supply any addition lubrication is simply not needed. Further, there is no reason to modify the sealing member 17 to

supply a lubricant because grease from the storage area 23 is present between the sealing member and the shaft 10 (see Nilsson, col. 2, lines 13 and 14).

Further, neither Chiba, Yabe or Asai provide any reason to modify Nilsson. For example, Chiba discloses that its element 7 (asserted by the Examiner to be a lubricant supply device) is an “oil coated felt,” (see abstract of Chiba). The oil-coated felt 7 of Chiba is part of a dust protective device for avoiding invasion of foreign material or chips, and is not for supplying lubricant to the screw shaft. Thus, the oil-coated member 17 in Chiba does not correspond to the lubricant supply device of the present invention. Also, there is no teaching that the oil in Chiba is even a “lubricant.” A skilled artisan will appreciate that an “oil” does not inherently teach or suggest a “lubricant.” For example, oils such as lamp oils, various light oils or animal oils could not properly serve as a lubricant for a linear guide device, even though it may trap dust, as required in Chiba.

For the multiple reasons noted above, it is respectfully submitted that there is no motivation to combination Nilsson with any of Chiba, Yabe or Asai to obtain the features of independent claims 17, 18, 19, 22, 31, 32, 33, 34 and 36, and dependent claims 37-45. Likewise, dependent claims 20, 21, 23-30 and 35 are deemed patentable over the references at least due to their respective dependencies on the independent claims.

**B) THERE IS NO MOTIVATION TO MODIFY NILSSON WITH EITHER
OF CHIBA, YABE OR ASAI TO INCLUDE A SIDE THAT COVERS AN AXIAL END
OF THE LUBRICANT SUPPLY DEIVCE.**

Claims 17, 18, 22, 31, 32, and 34 recite a side that extends radially inward to cover an axial end portion of the lubricant supply device. Claims 19 and 33 recite a side portion that

covers an axial end of the lubricant supply device. Claim 36 recites a side that extends radially inward to cover an axial end portion of the means for storing the lubricant.

An exemplary, non-limiting embodiment of the present invention is shown Figures 12 and 13, and includes a side extending radially inward to cover an axial end portion of the lubricant supply device. As noted above, it is acknowledged by the Examiner that Nilsson does not disclose this feature.

The Board of Patent Appeals and Interferences has maintained that most, if not all inventions, arise from a combination of old elements. (*In re Kotzab*, 55 USPQ2d at 1316 (*citing In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998))). Thus, every element of a claimed invention may often be found in the prior art. (*Id.*) However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. (*Id.*) Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant (emphasis added). (*In re Kotzab*, 55 USPQ2d at 1316 (*citing In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984))).

Chiba does not provide the requisite motivation to modify Nilsson. Chiba is applied for disclosing a housing member 8 and 9 which houses a felt element 7 having oil. On the other hand, the sealing member 17 of Nilsson is disposed within a washer 22 (which the Examiner applies against the claimed housing). The Examiner acknowledges that the alleged housing 22 of Nilsson does not include a side that extends radially inward to cover an axial end portion of

the sealing member 17. Instead, the housing of Nilsson is cut flush with the axial end face of the sealing member 17 to clearly avoid covering any portion of the axial end face of the sealing member 17. The sealing member 17 is fixedly held to the components 11 via a screw member and is acted upon by a compression spring 26.

There is clearly no reason that a skilled artisan would have modified the housing 22 to include a side that extends radially inward to cover an axial end of member 17. Nilsson does not disclose any problem with its housing that would require such an additional side. In fact, there are clear reasons why one would not have modified Nilsson to have the claimed features. For example, if the housing of Nilsson had the claimed additional side, the sealing member 17 would be trapped within the housing 17 and could not be backed out if needed, which would hinder assembly, as well as disassembly. Moreover, material and labor costs would increase if an additional side was added to the housing. In effect, there is clearly no motivation found in Nilsson to make such a modification, nor is there motivation found in Chiba to sensibly alter Nilsson.

Moreover, the felt 7 of Chiba is disposed between the wiper 9 and the felt housing 8, so that the felt member 7 is maintained in place. As noted above, the sealing member 17 of Nilsson is maintained in place via the screw. There is absolutely no need to provide any further means to maintain the position of the sealing member 17 in Nilsson. Any further means to maintain the position of the sealing member 17 would: 1) be superfluous, 2) not provide any additional benefit not already provided in Nilsson, and 3) would hinder the assembly/disassembly of Nilsson.

The alleged motivation set forth in the Office Action is to “protect the lubricant supply device from separating from the nut member so that the feet screw device would last longer.” (See Office Action, page 3, last sentence.) It is clear upon review of both Chiba and Nilsson that the references are mutually exclusive and utilize different means for maintaining their respective elements 7 and 17. The sealing member 17 of Nilsson is not unrestrained, nor is there any indication that its screw (large screw member shown in Figure 2) does not sufficiently maintain the sealing member 17.

Accordingly, Applicant respectfully submits that, for at least the many reasons noted above, there is no motivation to modify the housing of Nilsson to have the claimed features.

The combination of Nilsson and Yabe also fails to teach or suggest the features of independent claims 17-19, 22, 31-34 and 36. Yabe is applied for allegedly disclosing a housing member 41 and an alleged lubricant supply device 42. As noted above, based on the explicit teachings of Nilsson, there is no motivation to modify its housing 22 to include any end face that extends to cover the sealing member 17. In fact, doing so would hinder the assembly/disassembly of the device. Moreover, it is not even clear how the sandwich structure of Yabe (see Figure 4) would be applied to Figure 2 of Nilsson. Again, both these references teach completely different elements assembled in completely different ways. A skilled artisan provided with Figure 4 of Yabe surely would not have modified the housing 22 of Nilsson in the claimed manner.

The combination of Nilsson and Asai also fails to teach or suggest the features of independent claims 17-19, 22, 31-34 and 36. Asai is disclosed for allegedly teaching a housing member and a lubricant supply device 3. The grounds of rejection assert that the housing

member includes a side 1A that extends radially inward to cover an axial end portion of the lubricant supply device (see Figure 13A of Asai). For the reasons set forth above, it should be understood that there is no motivation to provide an additional end face to the housing 22 of Nilsson. Moreover, the side of Asai that is relied on is a sliding surface (1A), as noted in column 6, lines 5-11 of Asai. A skilled artisan will appreciate that the sliding surface 1A is not a side that extends radially inward. Instead, the surface 1A extends axially along the track 11. Moreover, the shaft of Nilsson includes grooved ridges. Therefore, if Nilsson were modified in accordance with a Asai, the surface 1A would clearly not “slide” as required by Asai. Accordingly, there is no motivation to modify Nilsson with the teachings of Asai.

In conclusion, Applicant submits that the respective combinations of: 1) Nilsson and Chiba; and 2) Nilsson and Yabe; and 3) Nilsson and Asai fail to provide a teaching or suggestion to combine their disclosures to obtain each feature recited in independent claims 17-19, 22, 31-34 and 36, such that the rejections under 35 U.S.C. § 103(a) should be withdrawn. The rejection of dependent claims 20, 21, 23-30, 35 and 37-45 should likewise be withdrawn at least by virtue of their respective dependencies upon the independent claims.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Patent No. 10/763,186

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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